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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,541	11/02/2000	Helmut Moehwald	48998	8978

26474 7590 10/28/2003  
KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

WEINER, LAURA S

ART UNIT	PAPER NUMBER
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1745

14

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/674,541

Applicant(s)

MOEHWALD ET AL.

Examiner

Laura S Weiner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 and 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Examiner acknowledges the cancellation of claims 15-17, 29 cited in Amendment B dated 10-23-02. Examiner acknowledges the cancellation of claims 1-13 and addition of claims 14-29 cited in Amendment A dated 11-2-00. Claims 14, 18-28 have been examined on their merits.

### ***Response to Arguments***

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claims 14, 20-22, 26, 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Bauer et al. (WO 99/19917).

Bauer et al. teaches a composite comprising at least one first layer which comprises a mixture and at least one second layer which comprises an electronconducting, electrochemically active compound. Bauer et al. teaches on pages 19-20, that the second layer may be made of homopolymers, copolymers or block copolymers IVa obtainable by polymerization of mixtures Ia or Ib; polycarbonates, halogen-containing olefinic compounds such as vinyl chloride, vinyl fluoride, vinylidene fluoride, hexafluoropropene, etc. Bauer et al. teaches on page 24, if the second layer is a cathode layer it comprises an electron-conducting, electrochemically active compound such as  $\text{LiCoO}_2$ ,  $\text{LiNiO}_2$ ,  $\text{LiNi}_x\text{CO}_y\text{Al}_z\text{O}_2$ , etc., a polymeric binder and conductive black ; if an anode layer it comprises lithium, lithium-containing metal alloys, oxides such as titanium oxide, zinc oxide, graphite, etc. and further comprises 20 % by weight, based on the total weight of materials present in it (polymeric binder plus anode compound), of conductive black. Bauer et al. teaches on page 47, the first layer comprises a mixture of Ia, comprising a mix IIa consisting of (a) from 1-95% by weight of a solid III having a primary particle size of from 5 nm to 20  $\mu\text{m}$  and (b) from 5-99% by weight of a polymeric composition IV obtainable by polymerization of b1) from 5-100 % by weight based on the composition IV.

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***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

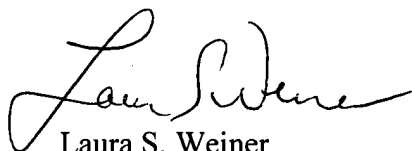
7. Claims 14, 18-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,475,663. Although the conflicting claims are not identical, they are not patentably distinct from each other because US 6,475,663 claims a composition comprising 0 to less than 1% by weight of a pigment (I) having a primary particle size of from 5 nm to 100 um which a solid (Ia) or a compound (Ib)

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which acts as cathode material in electrochemical cells or a compound (Ic) which acts as an anode in electrochemical cells or a mixture of the solid (Ia) with compound (Ib) or the compound (Ic), more than 99% by weight of a polymer or copolymer (IIa) containing reactive groups (RG) on the chain in terminal and/or lateral positions which are capable of crosslinking reactions in the presence of heat and/or UV radiation. Also claims a composite element comprising at least one first layer and that this composition can be used in a solid electrolyte, a separator, an electrode, a sensor, etc.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Weiner whose telephone number is (703) 308-4396. The examiner works a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan, can be reached at (703) 308-2383. The fax phone number for non-after finals is 703-872-9310 and the fax phone number for after-finals is 703-872-9311.



Laura S. Weiner  
Primary Examiner  
Art Unit 1745  
June 25, 2003